



UNITED STATES PATENT AND TRADEMARK OFFICE

MW)

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/365,651	08/02/1999	G. VICTOR TREYZ	SVT-1	2056

36532 7590 02/24/2004

G. VICTOR TREYZ
FLOOD BUILDING
870 MARKET STREET, SUITE 984
SAN FRANCISCO, CA 94102

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE
U.S. Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
---------------------------------	-------------	---	---------------------

EXAMINER

ART UNIT	PAPER
----------	-------

14

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

CUONG H. NGUYEN
Primary Examiner
Art Unit: 3625

**Notification of Non-Compliance
With 37 CFR 1.192(c)**

Application No.

09/365,651

Applicant(s)

TREYZ ET AL.

Examiner

CUONG H. NGUYEN

Art Unit

3625

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 24 November 2003 is defective for failure to comply with one or more provisions of 37 CFR 1.192(c). See MPEP § 1206.

To avoid dismissal of the appeal, applicant must file IN TRIPLICATE a complete new brief in compliance with 37 CFR 1.192(c) within the longest of any of the following three **TIME PERIODS**: (1) **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer; (2) **TWO MONTHS** from the date of the notice of appeal; or (3) within the period for reply to the action from which this appeal was taken. **EXTENSIONS OF THESE TIME PERIODS MAY BE GRANTED UNDER 37 CFR 1.136.**

1. ☐ The brief does not contain the items required under 37 CFR 1.192(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, pending or cancelled, or does not identify the appealed claims (37 CFR 1.192(c)(3)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 1.192(c)(4)).
4. ☐ The brief does not contain a concise explanation of the claimed invention, referring to the specification by page and line number and to the drawing, if any, by reference characters (37 CFR 1.192(c)(5)).
5. ☐ The brief does not contain a concise statement of the issues presented for review (37 CFR 1.192(c)(6)).
6. ☐ A single ground of rejection has been applied to two or more claims in this application, and
 - (a) ☐ the brief omits the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet presents arguments in support thereof in the argument section of the brief.
 - (b) ☐ the brief includes the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet does not present arguments in support thereof in the argument section of the brief.
7. ☐ The brief does not present an argument under a separate heading for each issue on appeal (37 CFR 1.192(c)(8)).
8. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 1.192(c)(9)).
9. ☒ Other (including any explanation in support of the above items):

The brief should contains a summary of invention with a concise explanation of the invention defined in the claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. The brief received on 11/24/2003 including a summary of the invention with stating that "All of these different aspects of applicants' invention are described in detail in applicants' specification". This statement does not conform to 37 CFR 1.192 ©


CUONG H. NGUYEN
Primary Examiner
Art Unit: 3625

DETAILED ACTION

1. This Office Action is the answer to the change of address, and the remarks received on 6/09/2003; which papers have been placed of record.
2. Claims 21-40 are pending in this application.

Response:

Independent claims 21, 33, and 38 were interpreted as below:

3. Claim 21: Order servicing **equipment** for an on-line system that allows a user to order image-based products over the Internet, comprising:

- a computer that receives an image; and printing equipment, wherein the order servicing **computer is configured to view image** on-line over the Internet, wherein the computer is configured to edit images, wherein the **printing equipment** is configured to print the edited digital image to create a print for framing, and wherein the computer is configured to **select** a given type of **frame**.

Claim 21 is rejected on 35 USC 103(a). It is merely directed to a system having:

- an Internet computer configured to:
 - receive images;
 - view images;
 - print images;
 - select given frames.

Please note that "the **printing equipment** is configured to print the edited digital image to create a print for fram" is a capability of a printer; moreover, this information is obvious.

Claim 33: Order servicing **equipment** that allows customers to place on-line orders for prints of digital images taken by a photographer at an event, comprising:

- a computer, wherein the order servicing computer uses an assignment title to identify the event, [wherein said computer is able to select different events - this is obvious because keyboard/mouse is inherent component to perform such claimed task], [“wherein in images a customer is a subject of the image” - this phrase is not part of that claimed apparatus; hence, it is not a limitation, “wherein the computer is configured to use the customer information in providing each of the customers with an opportunity to place an on-line order - these are obvious because a computer using customer’s information, (they are “functional descriptive material”) that do not contribute to make any structural component for said claimed apparatus].

At least, claim 33 is rejected on 35 USC 103(a). It is directed to an apparatus having:

- an Internet computer configured to:
 - receive images with information (title, a customer’s image);
 - print images;
- This claimed phrase is not a limitation of claimed system “taken by the photographer and is provided with customer information including a customer list that includes names of the customers for the event” because it does not contribute to create any structural component of that claimed system.

Please note that “Order servicing **equipment** that allows customers to place on-line orders for prints of digital images taken by a photographer at an event” is an intent of use of claimed apparatus, this is not a proper limitation.

Claim 38: Order servicing **equipment** that allows customers to place on-line orders for prints of digital images taken by a

photographer at an event, -wherein images include customers, comprising:

- a computer, wherein the order servicing computer is provided with images, wherein the computer is configured to view images - this is obvious -, to order wood and metal framed prints of the digital images over the Internet.

Claim 38 is rejected on 35 USC 103(a). It is directed to an apparatus having:

- an Internet computer configured to:
 - receive images with information (title, a customer's image .etc.);
 - view images;
 - "to order wood and metal framed prints of the digital images over the Internet" this is merely a capability of a computer that is obvious in e-commerce, because it does not contribute to create any structural component of that claimed apparatus.

Please note that "Order servicing equipment that allows customers to place on-line orders for prints of digital images taken by a photographer at an event," is an intent of use of claimed apparatus, this is not a proper limitation.

3.A. The examiner submits that saying "Oberg's system can generate order copies; not prints to be framed" is incorrect (see page 3, para. 2); Oberg's system is capable to perform that task, a printer in Oberg's system would perform the same task as in claim 21. It is not inventive to have a system being able to generate a print (for framing) (this is old and well-known step even with Kodak's or Fuji's articles that the applicants submitted for consideration). This above rationale would answer applicants' argument on page 4, para.1. It is true that Oberg's system does not expressly say the same claimed language as in the application; but this is an obvious rejection; Oberg's system is obvious in generating a prints (see **Oberg**, 4:41-50). In contrast to the argument on page 5, para. 1, the examiner submits that **Oberg's** system is able to use for ordering a frame (claiming that framing a picture wherein that picture is printed out from computer is not an inventive

concept (see claim **21**: "wherein the order servicing computer is configured to present the user with an opportunity to select a given type of frame for the print").

3B. The argument on page 5, 3rd para. is about **Oberg** makes no mention of albums of "different" materials; the examiner submits that a selection from user would imply that there are different materials to choose (see **Oberg**, the abstract); the inventor does not necessarily spell-out similar languages because one with ordinary skill in the art would know and understand about the equivalent (although different) meanings of this invention.

3C. For the argument on claim 31, the examiner submits that for identification/location purposes, those parameters (e.g., name, date, address .etc.) mentions in the cited references are exemplary. One with ordinary skill in the art would recognize that an email message may include a service provider's URL; because an email would contain many different things (please note that those different things are non-functional descriptive material which are old and well-known), one of them can be a service provider's website because this create a convenience for email receiver who likes to communicate with said service provider.

3D. For the argument on claim 32, (page 6, para. 2), the examiner submits that the claimed language "background" is a non-functional descriptive material; moreover, this limitation is old and well-known in the art for this "system" claim, (see claim **32**: The order servicing equipment defined in claim 21 wherein the order servicing computer is configured to provide the user with an opportunity to order a print of a digital image that includes the user as a subject and that includes a background different than the background against which the user was originally photographed). In other word, different

background (e.g., a black background or a white background for a picture does not make it inventive).

3E. For the argument on claim 33, (page 7, para. 2), the examiner submits that the claimed language "customer list" and "title" in a provider's database are old and well-known in the art. It is not inventive for a claimed system that having these features.

3F. For the argument on claims 34 and 39, (page 7, para. 4), the examiner submits that the claimed apparatus is reasonably interpreted by physical structures that making up that apparatus; i.e. backgrounds, print, a digital image, Internet etc. , (see claim 34: "The order servicing equipment as in claim 33 wherein at least one of the customers was originally photographed against a solid color background to produce a digital image and wherein that digital image was manipulated to replace the solid color background with a new background, and wherein a print of the digital image that includes the customer with the new background is provided for on-line ordering by the customer over the Internet).

3G. For the argument on claim 38, (page 7, para. 5 and page 8, para.1), the examiner submits that this claimed apparatus has old and well-known limitation as argued "Nothing in the Oberg, Weisman, or Nozaki references describes the ordering of wood or metal-framed prints". Furthermore, the examiner picks "wood framed prints" because the applicants use the word "or", artisans would recognize that wood framed prints are old and well-known features.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art

are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. A. Re. to claims 21, 23-28: They are rejected under 35 U.S.C. 103(a) as being unpatentable over **Oberg** (US PAT. 5,870,771), in view of **Nozaki et al.**, (US Pat. 6,349,194).

Oberg teaches an equipment for an on-line system that allows a user to order image-based products over the Internet, comprising:

- An order servicing computer that receives an uploaded digital image over the Internet; and digital printing equipment, wherein the order opportunity to view the uploaded digital image on-line over the Internet, wherein the order servicing computer is configured to provide the user with an opportunity to edit the uploaded digital image on-line over the Internet, wherein the digital printing equipment is configured to print the edited digital image to create a print for framing, and wherein (see **Oberg**, Brief Summary Text portion - para. 18):

"The software associated with the present invention is a program or set of programs that may interface with a mobile digital camera system, designed to be connected to computer processing means such as an IBM-PC or Macintosh computer, for taking pictures in digital format. Once a digital picture of the customer's object is taken, the computer will display it as two-dimensional or three-dimensional image on a display screen. The system may incorporate a device that presents an actual three-dimensional display, such as a holographic display system. The image can be modified if desired. There are various display screens that allow the customer to input a request to the system to analyze the color composition of the input and supply images of color-coordinated items, to search the database for coordinating products, to change the configuration of the framing products,

and to output data to various output devices. The system is capable of creating a composite visual concept of a customer's order and allows the customer to adjust the color, size, width and other characteristics of frames and matting materials until the desired combination is achieved. “

And in Detailed Description Text portion (para. 10):

“In FIG. 3, a computer display monitor 60 is shown with frame molding 62 and matting material 64 superimposed on an input image 66 that was supplied by the user by taking a snapshot of the artwork 68 with a digital camera 70 and inputting it into the microprocessor 72. The image processing software executing in the microprocessor allows the user to crop the image of the artwork to delete portions that the user does not wish to include in the final framed picture. After **the user selects the frame** molding and matting material combinations, the image processing software superimposes them on the input image and then allows the user to adjust the location, size and shape of the opening that is to be cut in the matting. The software program allows the user to save a number of composite images **for later review**. The images may be saved temporarily within the memory associated with the microprocessor, or the images may be downloaded to a separate storage device such as a diskette, or to a video tape recorded by a video cassette recorder.”)

Oberg does not expressly disclose that “an order servicing computer is configured to present the user with an opportunity to select a given type of frame for the print”.

However, that idea was analogously given in **Oberg's** abstract; furthermore, **Nozaki** et al. suggest that feature (see **Nozaki** et al., Detailed Description Text portion (para. 46): “At step #209, when the customer desires to change the sizes and positions of the image frame and audio frame in the template displayed on the screen, this may be carried out simply by using the mouse in a way to work on usual graphic software. When

the customer desires to add frames, new frames of selected sizes may be created by using an audio or image frame creating tool.”; or

In Detailed Description Text portion (para. 47):

“At step #211, audio information selected in the material window is linked to a selected audio frame, and image information selected in the material window to a selected image frame.”).

It would be obvious for one with ordinary skill in the art to implement **Oberg** 's ideas with **Nozaki** et al. 's suggestion to select a frame for a picture, since a framed picture could be placed in many places and increasing good values to the picture; all above cited references were in the same specific application of digital images for picture-ordering online, further more components in this “system” claim must be distinguished from cited prior art in terms of structure(s) rather than functions.

B. Re. to claim 23: The rationales and references for rejection of claim 21 are incorporated.

Oberg also teaches that a servicing computer is configured to crop an uploaded image on-line (see **Oberg**, the abstract).

C. Re. to claim 24: The rationales and references for rejection of claim 23 are incorporated.

Oberg also discloses that an order computer is configured to set up an account by providing a name, e-mail address (see **Oberg**, in Brief Summary Text portion (para. 10):

“U.S. Pat. No. 5,053,956 issued to Donald et al. discloses a system for retail trading comprising means for storing images of items being traded, means for identifying, selecting, and retrieving the stored images, and means for displaying retrieved images either alone or combined with an image supplied by the user. The disclosure and claims associated with Donald et al. cover a wide range of items that can be traded including

carpets, furniture, clothing, household textiles, home wares, and even motor vehicles. The system does not, however, teach an image processing system that includes means to combine various frame moldings and matting with artwork or the like, or to vary the color, size, or number of openings in matting materials. It also does not disclose means for using image storage space and processing capability efficiently, such as by storing only one segment of a design having a repetitive pattern and piecing segments together based on the size of the object selected by the customer, nor does it disclose or even suggest a system that will analyze the customer's artwork and then search for and **present images of frame moldings** and colored accent matting that coordinate with the artwork."

And in Brief Summary Text portion (para. 19):

"The system also includes a retrievable, interactive database composed of merchandising information such as products and materials, colors and designs available, model numbers, size, material type, and supplier source. The system is capable of **generating a bill of material** or order template that lists the customer's name, address, and phone number, the products or component materials selected, and it optionally allows store personnel to enter the cost, labor charges, and sales tax associated with the order or the software associated with the system may calculate these figures at the user's request." - *this shows that Oberg suggests of setting up an account*),

- **Oberg** suggests that a password is used and is configured to provide text associated with an image using Internet (see **Oberg**, in Brief Summary Text portion (para. 20):

"It is also anticipated that the program will perform project management control functions to assure timeliness in accomplishing projects, accounting functions, inventory tracking functions, and network interface functions for allowing multiple users within one store and

even between stores to access the present system. Customers will also have access to the software via the Internet which will allow them to make their selections, place orders, and make payment from their home. "

And in Detailed Description Text portion (para. 9):

"It is also anticipated that the present invention will have the capability to update inventory and accounting records 66 that are stored in the system to reflect the materials used in filling a customer's order. A project management feature in the present invention will help assure timeliness in accomplishing projects. Further, the present invention will include network capabilities so that multiple users within one store are able to experiment with various combinations of frame moldings and matting material for their artwork with or without the assistance of store personnel. Customers will also have access to the software via the Internet which will allow them to make their selections, place orders, and make payment from their home. The present invention may be used by a variety of customers including professional photographers who often have an inventory of ready-made frames or photo frames available for their customers to choose from. The photographer would be able to show his customer digital images of the photographs he has taken and also suggest various frames and matting material combinations to complement the photos.

Other Reference Publication (1):

FrameShop found on the Internet at: <http://www.visionworksinc.com/visionworksinc/FrameShop.html>. Jan. 20, 1997.").

D. Re. to claim 25: The rationales and references for rejection of claim 23 are incorporated.

Oberg also teaches that a servicing computer is configured to change image to different colors (see **Oberg**, in Abstract Text portion (para. 1):

"A computerized system having means for displaying a digital image of an object such as an object of artwork supplied by the user, analyzing the color composition of the image, searching a database for coordinating frame and matting material products, developing composite images of the user's input with the matching selections, and presenting the digital images to the user so the items may be previewed before placing an order. The system interfaces with a mobile digital camera system for taking digital pictures of input supplied by the customer. The image may be cropped or otherwise altered and combined with the selected frame molding and matting material combinations. The user may experiment with various features such as color, shape, size, width, number of openings, and other characteristics of frames and matting material until the desired combination is achieved. The system also includes a database of merchandising information such as products and materials, colors and designs available, model numbers, size, material type, cost, and supplier source. The system is capable of generating a printout of the composite image and associated data, and of storing the data for later use".

And in Brief Summary Text portion (para. 4):

"In many areas of interior design and furnishings, a customer is presented with a daunting array of products available from which to choose. Such products include carpeting, vinyl and wood floorings, wall coverings, upholstery and drapery fabrics, paint, furniture styles, and decorating accessories such as paintings, prints, sculpture and statuettes, woven wall hangings, crafts, and needlework. In the area of picture framing, it is known to provide a customer with small sections of frame moldings and matting of various textures and colors, and to select frame and matting combinations based on how they appear when held close to the artwork to be framed. Artwork may include prints, painting, needlework,

photographs, documents, and any other object a person would desire to have framed.

Framing products may include frame moldings, matting and related materials such as fillets and decorative designs that may be applied to the matting, and any other items used in framing artwork. For most prints, paintings, and related matter, it is difficult to envision how the total finished product will appear especially if the frame and matting samples are relatively small or the artwork is large in size. It is also cumbersome for store personnel trying to help the customer by holding the artwork up with the small sections of frame and matting near one corner or edge, so the customer can stand back for a better perspective. A further drawback is the difficulty in seeing how various widths, layers, colors, textures, and other enhancements of matting appears next to the artwork and frame molding".

And in Brief Summary Text portion (para. 8):

"Image processing and previewing systems are well known in various fields of the prior art, such as those described in U.S. Pat. Nos. 4,434,467 for calculating hair color; 4,546,434 for designing apparel; 4,149,246 for specifying custom garments; 5,195,030 for foot shape imaging and overlay; 5,343,386 for making electronically-produced postcards; and 5,432,904 for developing auto repair estimates. These devices, however, are substantially different in field of use, purpose, and construction and, accordingly, are not described in detail herein".

And in Brief Summary Text portion (para. 9):

"U.S. Pat. No. 5,291,395 issued to Abecassis for a wall covering storage and retrieval system applies to the area of home furnishings. The system disclosed therein allows a user to input information relating to particular styles, patterns, motifs, and colors. The system then outputs one or more numbers referring to samples of wall coverings and/or

coordinating products such as borders, fabrics, and bed linens that meet the customer's criteria. The system does not have an image database associated with it and, therefore, the customer cannot view samples of the selected wall coverings on a video monitor.

Instead, a customer must physically go to a separate location within a store or warehouse to view each product. U.S. Pat. No. 5,111,392 issued to Malin applies to the field of interior design and discloses a system for designing an arrangement of office furniture pieces in which the designer selects a basic shape for the furniture from a library of predetermined shapes, adjusts the dimensions, creates groupings, and selects finish, color, and fabrics needed to complete the design. The system disclosed in Malin does not, however, have means to allow a designer to input his or her own elements and incorporate them into the design, such as fabrics, paintings, or other decorating accessories. The designer is limited to the library database provided by the product manufacturer".

And in Brief Summary Text portion (para. 10):

"U.S. Pat. No. 5,053,956 issued to Donald et al. discloses a system for retail trading comprising means for storing images of items being traded, means for identifying, selecting, and retrieving the stored images, and means for displaying retrieved images either alone or combined with an image supplied by the user. The disclosure and claims associated with Donald et al. cover a wide range of items that can be traded including carpets, furniture, clothing, household textiles, home wares, and even motor vehicles. The system does not, however, teach an image processing system that includes means to combine various frame moldings and matting with artwork or the like, or to vary the color, size, or number of openings in matting materials. It also does not disclose means for using

image storage space and processing capability efficiently, such as by storing only one segment of a design having a repetitive pattern and piecing segments together based on the size of the object selected by the customer, nor does it disclose or even suggest a system that will analyze the customer's artwork and then search for and present images of frame moldings and colored accent matting that coordinate with the artwork".

And in Brief Summary Text portion (para. 13):

"Another object is to produce a visual display of an object to be framed in order to coordinate the dimensions and color characteristics of the frame to the object to be framed without having to handle the framing or matting material before the selection can be made".

And in Brief Summary Text portion (para. 14):

"Another object is to produce a video display of an object to be framed which will enable a customer to visualize various color schemes and physical dimensions of the framing and matting material items so that a decision can be made by the customer as to the most desirable arrangement of framing and matting material".

And in Brief Summary Text portion (para. 17):

"The present invention comprises a computerized system that provides means for developing a digital image of an object such as an object of artwork supplied by the user, analyzing the color composition of the image, searching a database for coordinating frame and matting material products, developing composite images of the user's input with the matching selections, and presenting the digital images to the user so the items may be previewed before placing an order".

And in Brief Summary Text portion (para. 18):

"The software associated with the present invention is a program or set of programs that may interface with a mobile digital camera system; designed to be connected to computer processing means such as an IBM-PC or Macintosh computer, for taking pictures in digital format. Once a digital picture of the customer's object is taken, the computer will display it as two-dimensional or three-dimensional image on a display screen. The system may incorporate a device that presents an actual three-dimensional display, such as a holographic display system. The image can be modified if desired. There are various display screens that allow the customer to input a request to the system to analyze the color composition of the input and supply images of color-coordinated items, to search the database for coordinating products, to change the configuration of the framing products, and to output data to various output devices. The system is capable of creating a composite visual concept of a customer's order and allows the customer to adjust the color, size, width and other characteristics of frames and matting materials until the desired combination is achieved".

And in Brief Summary Text portion (para. 19):

"The system also includes a retrievable, interactive database composed of merchandising information such as products and materials, colors and designs available, model numbers, size, material type, and supplier source. The system is capable of generating a bill of material or order template that lists the customer's name, address, and phone number, the products or component materials selected, and it optionally allows store personnel to enter the cost, labor charges, and sales tax associated with the order or the software associated with the system may calculate these figures at the user's request. A print command is

available to acquire one or more copies of the finished order including an image of the order, the bill of material, and the customer order cost".

And in Detailed Description Text portion (para. 2):

"Referring now to FIG. 1, the hardware required in the present invention is shown in block diagram form to represent the various components that may be connected to meet the user's requirements. Means for providing input into the system 20 are shown connected to a microprocessor 22 and may include such items as a keyboard, mouse, touch screen, data file, a voice recognition system, a digital image generator such as a digital camera, and any other peripheral devices capable of providing input to a microprocessor. The microprocessor 22 is also connected to one or more output means 24 which may include a visual display monitor, a modem, a facsimile machine, a printer, a magnetic storage device, a system that generates audible sounds for requesting input or otherwise sending a signal to the user, including voice signals, a video cassette recorder, television, and any other peripheral devices capable of accepting data output from the computer, prompting the user for input, displaying computer generated images and data, transmitting data, and/or storing computer generated images and data. Software 26 for controlling the input means 20 and the output means 24, for image processing and analysis, for database retrieval and storage, and for inventory and accounting functions is loaded into memory in the microprocessor. The instructions contained in the software 26 are executed by the microprocessor 22. The present invention also includes storage means 28 connected to the microprocessor 22 for storing images of frame moldings and matting material in digital format that may be processed by the software 26 and combined with images of artwork supplied by the user. Many frame moldings and matting materials are comprised of

repeating patterns or designs around the edges while some frames and matting material do not have a pattern associated with them. The present invention makes efficient use of the storage means 28 by storing only one full pattern, or just a small segment of digital images of frame moldings and matting material, and then using processing means in the software 26 to calculate the number of segments that must be pieced together to surround the periphery of the artwork. This implementation can be used whether the frame selected is a ready-made or photo frame with fixed dimensions, or custom-sized. If the frame is ready-made, the software is limited in the number of segments it can piece together on each side. This gives the customer a wide range of choices of frame moldings and matting material, while maximizing the number of images that may be stored. Other merchandising information pertaining to the frame moldings and matting material may also be stored such as colors and designs available, material identification numbers, size, material type, supplier source, prices, manufacturers, model numbers and whether the item is available in inventory. In an alternative embodiment, images of artwork may be stored in the system and retrieved by the customer. This would be convenient in situations where a customer wants to buy the artwork and have it custom-framed by the store..."

And in Detailed Description Text portion (para. 3):

"Any combination of the above-mentioned input means 20 may be used. The keyboard provides means for the user to input alphanumeric data as well as making choices from possible selections presented to the user on a display monitor. A mouse provides means for the user to position a cursor over a desired selection presented on a display monitor and click a button to indicate his choice to the system. A mouse can also be used to "grab and drag" portions of graphic images across the display screen, and is useful in sizing and

positioning functions such as adjusting the borders of matting. A touch screen comprises an array of sensors along the sides of a screen, such screen being either built into or overlaying a video display monitor upon which graphics generated by the microprocessor are displayed. The graphics typically include annotated selection areas corresponding to the user's possible choices. When a user touches the screen in the location corresponding to his selection, the light detected by some of the sensors is blocked and the location of this interruption is registered by the system. The input from these devices then control the functions performed by the software 26 residing in the microprocessor 22. Alternatively, a data file may be used to provide input to the software programs and may contain information such as the size of the artwork to be framed, colors for the matting material, the number of matting desired and the dimension and location of the opening for each, model numbers of frame molding, or any other information required by the software to generate output. The data file may be stored in the microprocessor's memory or it may be supplied on a diskette, CD ROM, or other magnetic storage device..."

And in Detailed Description Text portion (para. 5):

"Referring now to FIGS. 2A, 2B, and 2C, at the beginning of a session at 29, a customer chooses to select from images of artwork already stored in the system at 30 or, alternatively, a customer can input a digital image of an object to be framed to the system through a digital camera 32. Once input is supplied, the system outputs a digital image of the object at 34 to a display that is visible to the customer. The digital image can then be modified at 36 as the software allows the customer to crop the edges, delete unnecessary or undesirable portions of the image, or alter the image in some other way such as by

changing colors or features, or combining the original image with portions from other digital images...".

And in Detailed Description Text portion (para. 6):

"Once the input image appears in a form the customer desires to have framed, the system allows the customer to choose whether to have the system analyze the image at 38, and search the database for coordinating products at 42, or the customer may decide to search the product database at 46 on his own. The portion of the software that analyzes the input 40 and develops its own combinations from the products available in the database 42 is an expert system that emulates store personnel who are trained in selecting coordinating combinations of frame molding and matting material based on the color composition and subject matter of the artwork. Thus, this portion of the software can be sophisticated enough to perform image recognition to determine the subject matter, or it may prompt the user to input the general subject matter of the artwork such as nature scenes, animals, people, formal or informal settings, and whether the customer wants to limit the search to particular types of materials, such as wood or metal. The software is also capable of analyzing the input image for color composition, determining dominant and secondary colors, and presenting combinations that complement the artwork. The customer may also instruct the system to search for coordinating combinations within a certain price range. If the customer decides to search the product database on his own, the software in the present invention allows him to search according to various input criteria such as types of materials for frame molding, matting material colors, cost, or whether he desires a ready-made frame or a custom-made frame...".

And in Detailed Description Text portion (para. 8):

"The software associated with the present invention also allows the customer to adjust sizes and colors of the frame and matting material at 54 once they are combined with the input image. If the customer is pleased with the result, he can then store the candidate combination for later review at 56 once he has viewed the remaining initial selections.").

E. Re. to claim 27: The rationales and references for rejection of claim 21 are incorporated.

Oberg teaches that a computer is configured for a user to order frames of different colors and is configured to provide the user with an on-line opportunity to order albums of different materials.(see **Oberg**, in Abstract Text portion (para. 1):

"A computerized system having means for displaying a digital image of an object such as an object of artwork supplied by the user, analyzing the color composition of the image, searching a database for coordinating frame and matting material products, developing composite images of the user's input with the matching selections, and presenting the digital images to the user so the items may be previewed before placing an order. The system interfaces with a mobile digital camera system for taking digital pictures of input supplied by the customer. The image may be cropped or otherwise altered and combined with the selected frame molding and matting material combinations. The user may experiment with various features such as color, shape, size, width, number of openings, and other characteristics of frames and matting material until the desired combination is achieved. The system also includes a database of merchandising information such as products and materials, colors and designs available, model numbers, size, material type, cost, and supplier source. The system is capable of generating a printout of the composite image and associated data, and of storing the data for later use."

And in Brief Summary Text portion (para. 13):

"Another object is to produce a visual display of an object to be framed in order to coordinate the dimensions and color characteristics of the frame to the object to be framed without having to handle the framing or matting material before the selection can be made"

And in Brief Summary Text portion (para. 17):

"The present invention comprises a computerized system that provides means for developing a digital image of an object such as an object of artwork supplied by the user, analyzing the color composition of the image, searching a database for coordinating frame and matting material products, developing composite images of the user's input with the matching selections, and presenting the digital images to the user so the items may be previewed before placing an order".

And in Brief Summary Text portion (para. 18):

"The software associated with the present invention is a program or set of programs that may interface with a mobile digital camera system, designed to be connected to computer processing means such as an IBM-PC or Macintosh computer, for taking pictures in digital format. Once a digital picture of the customer's object is taken, the computer will display it as two-dimensional or three-dimensional image on a display screen. The system may incorporate a device that presents an actual three-dimensional display, such as a holographic display system. The image can be modified if desired. There are various display screens that allow the customer to input a request to the system to analyze the color composition of the input and supply images of color-coordinated items, to search the database for coordinating products, to change the configuration of the framing products, and to output data to various output devices. The system is capable of creating a

composite visual concept of a customer's order and allows the customer to adjust the color, size, width and other characteristics of frames and matting materials until the desired combination is achieved.”).

F. Re. to claim 28: The rationales and references for rejection of claim 21 are incorporated.

Oberg teaches that the order servicing equipment defined in claim 21 wherein the order servicing computer is configured to allow the user to add audio to uploaded digital image(s) over the Internet. (see **Oberg**, in Detailed Description Text portion (para. 2): “Referring now to FIG. 1, the hardware required in the present invention is shown in block diagram form to represent the various components that may be connected to meet the user's requirements. Means for providing input into the system 20 are shown connected to a microprocessor 22 and may include such items as a keyboard, mouse, touch screen, data file, a voice recognition system, a digital image generator such as a digital camera, and any other peripheral devices capable of providing input to a microprocessor. The microprocessor 22 is also connected to one or more output means 24 which may include a visual display monitor, a modem, a facsimile machine, a printer, a magnetic storage device, a system that generates audible sounds for requesting input or otherwise sending a signal to the user, including voice signals, a video cassette recorder, television, and any other peripheral devices capable of accepting data output from the computer, prompting the user for input, displaying computer generated images and data, transmitting data, and/or storing computer generated images and data. Software 26 for controlling the input means 20 and the output means 24, for image processing and analysis, for database retrieval and storage, and for inventory and accounting functions is loaded into memory in the microprocessor. The instructions contained in the software 26 are executed by the microprocessor 22”).

Claims **29-40** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Oberg** (US PAT. 5,870,771), in view of **Nozaki et al.**, (US Pat. 6,349,194), and **Melissa A. Weisman's** disclosure.

G. Re. to claims 29-30: The rationales and references for rejection of claim 21 are incorporated.

Oberg teaches that the order servicing equipment is configured to provide the user with an on-line opportunity to select from different mat styles for corresponding selected frames (see Oberg, the abstract), and make orders (see Weisman's article).

H. Re. to claim 31: The rationales and references for rejection of claim 21 are incorporated.

Oberg teaches that the order servicing computer is configured to email a message to a party other than the user over the Internet, wherein the message includes a URL that allows the party to view and order prints (see Weisman's article, and see Oberg, US PATENT NO. 5870771, And in Brief Summary Text portion (para. 19):

"The system also includes a retrievable, interactive database composed of merchandising information such as products and materials, colors and designs available, model numbers, size, material type, and supplier source. The system is capable of generating a bill of material or order template that lists the customer's name, address, and phone number, the products or component materials selected...").

One of ordinary skill in the art would recognize an identity for a location (e.g., a URL) is necessary in an email communication because this is very convenient in communications to related parties.

I. Re. to claim 32: The rationales and references for rejection of claim 21 are incorporated.

Weisman teaches that the order servicing computer is configured to provide the

user with an opportunity to order a print of a digital image that includes the user as a subject (see Weisman's article for this idea, it was suggested as ordering a picture of "wedding guest"), and that includes a background different than the background against which the user was originally photographed.

P. 2
3rd para.

background

color

5. Claim **22** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Oberg** (US PAT. 5,870,771), in view of **Nozaki et al.**, (US Pat. 6,349,194), and in view of **Plettinck et al.**, (US Pat. 5,689,349 filed 1994).

The rationales and references for rejection of claim 21 are incorporated. **Oberg** and **Weisman** do not disclose that an order equipment comprises packaging equipment.

However, **Plettinck et al.**, suggest that idea in Brief Summary Text portion (para.5): "The method of the present invention is capable of many applications for printing color prints, such as packaging or pictures in periodicals or books.").

It would be obvious for one with ordinary skill in the art to implement **Oberg** 's ideas with **Nozaki et al.** 's, and **Plettinck** 's suggestion to include a packaging equipment in the claimed system for mailing finished products to customers according to ordering items.

6. Re. to claim 26: It is rejected under 35 U.S.C. 103(a) as being unpatentable over **Oberg** (US PAT. 5,870,771), in view of **Nozaki et al.**, (US Pat. 6,349,194), or **Melissa A. Weisman**'s disclosure, further in view of **Bruck et al.** (US Pat. 6,008,836).

The rationales and references for rejection of claim 25 are incorporated. **Oberg** suggests a computer is configured to change image color/contrast.

Furthermore, **Bruck et al.** clearly define a selection of image's contrast (see **Bruck et al.**, "The user selects the contrast setting in accordance with the optimum contrast of the test pattern. After the user sets the contrast of the display to the proper position, he selects the continue anchor 83 to invoke the next picture adjustment screen.

CLAIMS:

3. A method according to claim 2, wherein the one or more activated interactive user instructions indicate that the user is to adjust the contrast of the television monitor until the test pattern exhibits a desired contrast

attribute, the step of adjusting the one or more selected characteristics of the picture comprising the step of responding to user input generated as the user adjusts the contrast of the television monitor.

8. A method according to claim 2, wherein said one or more selected characteristics of the picture comprise a display characteristic selected from the group consisting of contrast, brightness, sharpness, color and hue.

21. A computer program product according to claim 20, wherein the downloaded interactive user instructions indicate to a user how to adjust one or more selected characteristics of the picture, wherein the one or more selected characteristics comprise a display characteristic selected from the group consisting of contrast, brightness, sharpness, color and hue”).

It would be obvious for one with ordinary skill in the art to implement **Oberg** 's ideas with **Weisman** or **Nozaki** et al., and **Bruck** et al. 's suggestion to select a frame for a picture, since **Bruck** et al. suggest in a digital world, a contrast could be changed in order to give a selected picture.

The examiner submits that a software for cropping image has been existed prior to this invention. That cropping task would be done before uploading a digital image (from using a user's computer software), or after uploading a digital image (from using a picture processing software).

7. Re. To claim 33: This "system" claim contains similar features as in system claims **21**, **24**, and **32**. Therefore, similar rationales and references set forth are applied for a rejection under 35 U.S.C. § 103(a) on cited art of **Oberg**, and **Weisman**, or **Nosaki** et al.

8. Re. To claim 34: This "system" claim contains similar features as in system claims **21**, **25**, and **26**. Therefore, similar rationales and references set forth are applied for a rejection under 35 U.S.C. § 103(a) using **Oberg** (US Pat. 5,870,771), and **Weiseman**'s disclosure or **Nozaki** et al. (US Pat. 6,349,194).

9. Re. To claim 35: This "system" claim contains similar features as in a system claim **21**. Therefore, similar rationales and references set forth are applied for a rejection under 35 U.S.C. § 103(a) using **Oberg** (US Pat. 5,870,771), and **Weiseman's** disclosure or **Nozaki et al.** (US Pat. 6,349,194).

10. Re. To claim 36: This "system" claim contains similar features as in a "system" claim **23**. Therefore, similar rationales and references set forth are applied for a rejection under 35 U.S.C. § 103(a) using **Oberg** (US Pat. 5,870,771), and **Weiseman's** disclosure or **Nozaki et al.** (US Pat. 6,349,194).

11. Re. To claim 37: This "system" claim contains similar features as in "system" claims **21, 25, and 26**. The acts of editing/updating/changing background are obvious to this computer application. Therefore, similar rationales and references set forth are applied for a rejection under 35 U.S.C. § 103(a) using **Oberg** (US Pat. 5,870,771), and **Weiseman's** disclosure or **Nozaki et al.** (US Pat. 6,349,194).

12. Re. To claim 38: This "system" claim contains analogous features as in a system claim **21**. The generic acts of viewing/ordering different frames for digital images are obvious to this computerized-application business. Therefore, similar rationales and references set forth are applied for a rejection under 35 U.S.C. § 103(a) using **Oberg** (US Pat. 5,870,771), **Weiseman's** disclosure or **Nozaki et al.** (US Pat. 6,349,194).

13. Re. To claim 39: The rationales and references for rejection of claim 38 are incorporated.

This "system" claim contains analogous features as in a system claim **32**. The acts of editing/updating/changing to different backgrounds are obvious to this computerized-application business for one of ordinary skill in the art since having pictures with different backgrounds are old and well-known.

14. Re. To claim 40: The rationales and references for rejection of claim 21 are incorporated.

This "system" claim contains similar features as in a system claim **21** because of Internet capability in communications. One of ordinary skill in the art would recognize that Internet can be used to communicate anywhere in the globe.

15. The claiming subject matter is only directed to viewing and ordering image-based products on the Internet (this subject matter is not an inventive concept at the time of the invention).

These limitations belong to a fundamental concept in doing retailed business of ordering processed images online. One skilled in the art can ascertain essential characteristics of cited references and, without departing from their spirit and scope thereof, can make various modifications of these references to adapt its subject matter to various usages and conditions in film processing business. It would be obvious for one with ordinary skill in the art to implement Weisman or Nozaki et al. 's ideas with Öberg 's suggestion to perform specific functions as claimed, because components in this system claim must be distinguished from cited prior art in terms of structure(s) rather than functions. Cited prior art limitations are not necessary spelled-out exactly claimed languages, because cited prior art are also directed to an analogous application as what the applicants did. The cited references should not be limited to described embodiments in their disclosures.

Conclusion

16. All pending claims are rejected.

17. These references are considered pertinent to applicants' disclosure:

- **Melissa A. Weisman**, Internet wedding albums reach far-flung relatives, The Patriot Ledger, Quincy, 10/21/1998 (from ProQuest).

- **Smart et al.** (US Pat. 6,185,371, filed on 12/28/1998, issued on 2/06/2001, US Class 396/6; 396/311; 396/429) "Photo finishing method, photo finishing apparatus, and system" where in 35 USC 103(a) rejection is used based on Smart claims 3-4, 6-7, 14-15. A photo finishing system includes film units, a remote look-up table, and photo finishing apparatus. The photo finishing apparatus has a reader to read identifiers on the film units, a communicator to interface with the look-up table to poll the table for photo finishing parameters for the film units, and a processor that generates digital images responsive to the photo finishing parameters. In a method, a film unit containing a plurality of captured images is received. A remote look-up table having a logical memory unit uniquely associated with the film unit is accessed. The logical memory unit designates a plurality of photo finishing parameters for the film unit. The film unit is processed responsive to the photo finishing parameters. Information about the processing of the film unit is recorded in the logical memory unit.

- **Haneda**, (United States Patent 6,459,511, filed on 3/19/1998, issued on October 1, 2002; Current U.S. Class:

358/506; 358/302; 396/311; Foreign Application Priority Data

Jul 29, 1994[JP]6-196213; Jul 29, 1994[JP]; 6-196214 Sep 30, 1994[JP] 6-261678; Jun 29, 1995[JP] 7-185012.) "Laboratory system, method of controlling operation thereof, playback apparatus and method, film image management method, image data copying system and method of copying image data" wherein Images of film that has been developed are captured by image sensing, thereby being converted to original digital

image data representing these images. The original digital image data is converted to reduced digital image data representing images that are reduced in size. The reduced digital image data is stored on a user's disk, and the original digital image data is stored on a laboratory recording medium together with an identification code identifying the roll of film. The identification code is applied to the film and to the user's disk on which the reduced digital image data has been stored. The original digital image data is read out of the laboratory recording medium and photographs of the images represented by this data are printed. The identification code may be recorded on the user's disk instead of being applied thereto. A program (hypertext) for reproducing the images also is stored on the user's disk. Image data, information IX1 per each roll of film and information IX2 per each frame are read from photographic film having information recording zones, and the image data and information are recorded on a user's disk. Resources comprising a video component (image data) such as a frame image or the like for being combined with a film image, and an audio component (sound data) such as background music or narration are also recorded on the user's disk in advance. Slide-show program composed of information indicating a playback sequence, information relating to combinations of film images and video components and information for controlling the generation of sound is created in a playback apparatus and recorded on the user's disk. In accordance with the slide-show information, film images and video components are combined and displayed in a designated sequence and sound is played by the audio components. This presents a slide show. Image data is read out of a copy-source recording medium image by image, and reduced image data, which represents reduced images obtained by reducing the size of images represented by the image data read out of the copy-source recording medium, is

created image by image. An image file including images read out of the copy-source recording medium and an index file including the reduced image data created are recorded, in mutually associated form, on a copy-destination recording medium in units of the copy-source recording medium.

- **Stroschin et al.**, (US Pat. 5,453,926 - filed 5/25/1994), Touch screen system for a web folder (see Stroschin, claim 25 wherein copying/displaying an edited digitized image was disclosed).

- **Maniwa et al.**, (US Pat. 5,768,483 with priority date: 9/26/1995), Method of reporting result of execution of print job in network system, method of setting scanning conditions in network system, and network printing/scanning system; wherein scanning images were put into a library/files for retrieval later.

- **Chretienat et al.**, (US Pat. 6,167,806 with priority date: 3/11/1998), Device for controlling the printing of web materials in a rotary printing press (see Chretienat, claims 1-2, and 8 for disclosures of editing/inserting digital images on the web).

FUJI PHOTO FILM CO. LTD, (DERWENT-ACC-NO: 2001-429341 with priority date: 8/11/1999), discloses about network access control method for online photograph service system as pending application, involves printing photograph based on digital image data and purchase order information received from respective sources and external network.

- **Tsue T. of FUJI PHOTO FILM CO. LTD**, (DERWENT-ACC-NO: 2001-625032 with priority date: 3/29/2000), discloses about a template displaying method for network photograph service system as pending application, involves generating catalogs of templates, having user images, and displaying the catalogs.

- **Kono et al.**, (PUB-NO: JP02001249990A, application date: 3/03/2000), disclose an image service system and computer readable storage medium, wherein they suggest of providing an image service system capable of facilitating ordering, improving convenience in terms of management and the efficiency of work and performing quick service.

- **Telepix** imaging provides unique digital imaging products and services for London drugs photo finishing needs, Canada Newswire, 9/16/1998; wherein it discloses about letting customers easily organize, upload and download their photos and photo creations.

News Network, 9/13/1996

- From Dialog Classic Web file 9, Kodaks new small office/home zoom digital camera, Newsbytes News Network, 9/15/1997, wherein Easy 2.0 software can allows simple changes and enhancements to images and then can e-mail/print/upload/place orders with print service. These steps are similar as what this pending application suggested.

- From DialogClassic Web™ file 9, **Kodak's** new small office/home zoom digital camera, Newbytes News Network, 9/05/1997. This document discloses that a variety of digital photo editing software packages are available.

- From DialogClassic Web™ file 648, President and chief executive officer of Seattle Filmworks, Inc., Wall Street Corporate Reporter, 2/26/1996. This document discloses that online film-processing are available.

- **Jahnke**, Kodak stays in the digital picture, 8/06/1999, CNN.com, this article reviews Kodak's film-processing activities including Kodak PhotoNet online and Kodak Picture Playground online.

- **Arar**, Get the picture, however you want it, 6/24/1999, CNN.com, this article discloses that a number of Web-based services are popping up to serve the rapidly

expanding digital photography market; and Adobe Systems is a developer of the popular PhotoDeluxe image-editing software.

- From DialogClassic Web™ file 20, Telepix imaging provides unique digital imaging products and services for London drugs photo finishing needs, Canada Newswire, 9/16/1998.

Conclusion

18. Claims **21-40** are not patentable. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

19. Note: The independent claim 21 directed to an "equipment"; therefore, this equipment/apparatus/system covers what that equipment/apparatus/system is, not what an equipment does.

- a limitation on a claim can be thought of as its ability to make a meaningful contribution to the definition of the invention in a system claim. In other words, language that is not functionally interrelated with the useful structure of the claimed invention will not

serve as a limitation (claim 21 is directed to an equipment; therefore, any system having similar component/module would be sufficient for an obviousness rejection.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cuong H. Nguyen whose telephone number is 703-305-4553. The examiner can normally be reached on Mon.-Fri. from 7AM to 3:15 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins, can be reached on (703)308-1344.

Any response to this action should be mailed to:

Amendments

**Commissioner of Patents and Trademarks
Washington D.C. 20231**

or faxed to: (703)305-7687 [Official communications; including
After Final communications labeled "Box AF"]

703-746-5572 (RightFax) Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th floor receptionist.

Any inquiry of a general nature or relating to the status of this application or proceeding
should be directed to the Receptionist whose telephone number is (703)308-1113.

Cuong H. Nguyen

Primary Examiner
August 22, 2003